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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/508,692	03/29/00	ALBERTINI	J 0846-0544-2-

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EXAMINER	
DONOVAN, L	
ART UNIT	PAPER NUMBER

2832

DATE MAILED:

15
11/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/508,692

Applicant(s)
Albertine et al.

Examiner
Lincoln Donovan

Art Unit
2832



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 9, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-37 is/are pending in the application.
- 4a) Of the above, claim(s) 30-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Mar 29, 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

Continued Prosecution Application

1. Receipt is acknowledged of the "conditional" request for a Continued Prosecution Application (CPA) filed on 07-25-01 under 37 CFR 1.53(d) based on Application No. 09/508,692. Any "conditional" request for a CPA submitted as a separate paper is treated as an unconditional request for a CPA. Accordingly, the request for a CPA application is acceptable and a CPA has been established. An action on the CPA follows.

Election/Restriction

2. Claims 30-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected process of manufacturing a magnetic circuit, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 14.

3. Applicant's election with traverse of the restriction in Paper No. 13 is acknowledged. The traversal is on the ground(s) that no "serious burden" is placed on the examiner "even though it includes claims to independent or distinct inventions." This is not found persuasive because the search for the apparatus is significantly different than that for the method.

The requirement is still deemed proper and is therefore made FINAL.

Priority

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4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

5. The drawings are objected to because cut-away views of insulative materials, for example insulating layer 26, must be cross-hatched as such. Correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 20-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 20, lines 2-3, applicant should clarify what is intended by “the magnetic layer ‘channeling’ a magnetic field.” In line 2, applicant should clarify what is intended by the magnetic layer being “broken.” Claims 21-23 inherit the defects of the parent claim.

Regarding claim 24, lines 1-2, applicant should clarify what is intended by the “magnetic layer ‘channeling’ a magnetic field.” In line 2, applicant should clarify what is intended by the magnetic layer being “broken.” Claims 25-27 inherit the defects of the parent claim.

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Regarding claim 28, lines 1-2, applicant should clarify what is intended by the “magnetic layer ‘channeling’ a magnetic field.” In line 2, applicant should clarify what is intended by the magnetic layer being “cut.”

Regarding claim 29, lines 1-2, applicant should clarify what is intended by “a rounded rear portion” and “side magnetic branches.” In line 2, applicant should clarify what is intended by the “magnetic layer ‘channeling’ a magnetic field.” Applicant should specify what is intended by “a certain direction.” In line 3, applicant should clarify what is intended by the magnetic layer being “cut.”

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 20-29, as best able to be understood in view of the rejections under 35 U.S.C. 112, second paragraph, are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 3-238804 in view of EPO 0308334.

Japan 3-238804 discloses a magnetic circuit [figure 1b] comprising:

- a single magnetic layer [1] “channeling” a magnetic field along a “given direction;”
- an semi-insulating layer [2] supporting the magnetic layer; and

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- evenly spaced walls on the semi-insulating layer extending perpendicular to the "given direction" of the magnetic field [figure 1b].

Japan 3-238804 disclose the instant claimed invention except for: the semi-insulating layer being insulative.

EPO 0308334 discloses an insulating layer [6] supporting a plurality of magnetic layers [8].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use insulative material for the semi-insulating layer of Japan 3-238804 for the purpose of controlling the magnetic field.

Regarding claims 26 and 28-29, the particular shape and number of layers would have been an obvious design consideration based on the intended application of the device.

Conclusion


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lincoln Donovan whose telephone number is (703) 308-3111.

The fax number for this Group is (703)308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0956.

LDD

November 8, 2001


LINCOLN DONOVAN
PRIMARY EXAMINER
GROUP 2100